IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Board of Patent Appeals and Interferences

Appellant:

Beka SOLOMON

Application No. 09/441,140
Filed: November 16, 1999
Appeal No: 2011-009879

PREVENTION OF PROTEIN AGGREGATION

Confirmation No: 3910
Attorney Docket No: SOLOMON1R

REVISED PETITION UNDER 37 C.F.R. §41.3

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Moments ago a petition was filed in this case. Because of a computer glitch, the version filed was not the final version (see the added penultimate paragraph added here). Accordingly, please disregard the petition filed moments ago and consider only the present "Revised Petition under 37 C.F.R. §41.3."

Pursuant to 37 CFR §41.3, appellant hereby petitions the Chief Administrative Patent Judge for permission to file a supplemental reply brief in this case, which presents additional arguments not previously made in appellant's main brief on appeal or reply brief and which, *inter alia*, requests that certain claims be considered separately from certain other claims. The supplemental reply brief to be filed upon acceptance of this petition is submitted herewith.

The present application on appeal is an application for reissue of U.S. Patent 5,688,651. Appellant's main brief on appeal was filed on November 10, 2010. An examiner's answer was issued on March 30, 2011, and appellant filed a reply brief and a request for oral hearing on May 31, 2011.

A divisional of the present reissue application was filed on February 22, 2006, and received application no. 11/358,951. That divisional application is also on appeal. Appellant's main brief on appeal was filed in that appeal on June 30, 2011. An examiner's answer was mailed on August 22,

2011, and appellant's reply brief and a request for oral hearing were filed on October 24, 2011.

Many of the issues in the two appeals are similar, if not identical. Accordingly, appellant has requested that the two appeals be argued together at a single consolidated oral hearing. Indeed, a previously set Oral Hearing in the present appeal was ordered to be rescheduled to allow the consolidated hearings of the two closely related appeals, as can be seen from the Order Granting Request to Reschedule Oral Hearing dated September 1, 2011, in the record of this appeal.

Because of the timing of the two appeals, the reply brief was filed in the present appeal prior to the date that the examiner's answer was received in the appeal of the divisional application. In preparing appellant's reply brief in the divisional application, appellant realized that the examiner had made new grounds of argument in response to appellant's arguments in that case, particularly as relating to the discussion of unexpected results that rebut any *prima facie* case of obviousness. In responding to this new ground of argument, raised by the examiner for the first time in the examiner's answer in the divisional application, appellant realized that certain claims were not subject to this argument and, accordingly, in the reply brief, appellant requested a

new grouping of claims with respect to the prior art rejection in question.

The applicable regulation with respect to appeal briefs, as set forth at 37 CFR §41.37(c)(1)(vii), states:

> Any arguments or authorities not included in the brief or a reply brief filed pursuant to §41.41, will be refused consideration by the Board, unless good cause is shown. … Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claims separately. Any claim argued separately should be placed under a subheading identifying the claim by number.

In the present appeal, appellant argued in the reply brief that the showing of unexpected results of record rebutted any *prima facie* case of obviousness that may have been established by the examiner in the rejection of claims 177, 210-213, 215-217, 219-223 and 225-227 under 35 USC 103(a) as being unpatentable over Walker as evidenced by Hanan and Bacskai, in view of Becker.

In the divisional application, application no. 11/358,951, claims 5, 7-9, 17, 19-21 and 31-38 of that application were rejected over substantially the same combination of references for substantially the same reasons. In the examiner's answer filed in the appeal of the divisional application, the examiner argued for the first time that the

evidence of unexpected results relied upon by applicant was not commensurate in scope with the entire range of the claimed invention. The examiner stated that many of the antibodies used in appellant's evidence were not obtained using an immunogen consisting of residues 1-28 of β-amyloid, as is required by the claims, and therefore fall outside of the scope of such claims. In appellant's reply brief filed in the appeal of the divisional application, appellant traversed this position of the examiner but separately argued that independent claims 31 and 35, and those claims dependent therefrom, were not subject to this argument as the antibodies used in those claims were defined, *inter alia,* by the language "wherein said anti-β-amyloid antibody is one that recognizes an epitope within residues 1-28 of β-amyloid." The reply brief requested that these claims, which were argued separately in the reply brief, be considered to be in a separate group for the purpose of this rejection and considered separately by the Board.

As the definition of the antibody in the claims of both the present application and the divisional are very similar, and as the rejection in question is substantially the same in both cases, it would be appropriate to respond to this new argument also in the present application.

As it has been requested that the two cases be consolidated for oral argument, it is apparent that the Board will be cognizant of the arguments made in the examiner's answer in the divisional application when considering the claims of the present application. Accordingly, it is important that the responses to these arguments as were made in the divisional application also be made in the present appeal so that similar claims in the two cases can be disposed of in a like manner by the Board. This would promote judicial economy and avoid inconsistent results that would potentially happen if such arguments were of record in one case but not in the other.

Accordingly, the attached Supplemental Reply Brief is necessary in order to comply with the requirements of Board Rule 41.37(c)(1)(vii), quoted above, so that the same arguments made in the divisional application can be considered by the Board in the present application. Also, this will establish a grouping of claims argued in the briefs in this case that will allow separate consideration of those claims stating that the antibody recognizes an epitope within residues 1-28 of β-amyloid, i.e., independent claims 215 and 225, and those claims dependent therefrom, on the one hand, and those claims containing the language that the antibody "is obtainable using an immunogen consisting of a peptide

consisting of residues 1-28 of β-amyloid," i.e., independent claims 210, 212 and 219, and those claims dependent therefrom, on the other hand. Note that other than the changes in the claim numbers, the arguments presented in the attached Supplemental Reply Brief are substantially the same as the corresponding arguments made in the reply brief filed in the divisional application appeal.

Good cause for the granting of this petition lies in the fact that new arguments that are applicable to rejections of record in the present appeal were first made by the examiner in the divisional application after the reply brief had been filed in this appeal. Note that the same examiner wrote both examiner's answers. As the appeals will presumably be consolidated for oral argument, it is important that the Board be able to consider the same arguments with respect to corresponding claim language in both cases and not be hamstrung by the technicality that some arguments were only made in the divisional application appeal but were not made in the present appeal because appellant was unaware of the examiner's arguments until after the reply brief had been filed.

Petitioner is aware of Board Rule 41.3(e)(1)(i), which states:

> (e) *Time for action.* (1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:
>
> > (i) File the petition within 14 days from the date of the action from which the party is requesting relief, ….

However, it is not believed that this is applicable to this kind of petition. Petitioner is not requesting relief from an action. Petitioner is requesting permission to do something that is not comprehended by the rules. In any event, petitioner hereby states that the present petition is being filed within 14 days of the time that petitioner first became aware of the new argument raised by the examiner in the examiner's answer filed in the divisional application and the desirability of responding thereto.

In any event, to the extent that the Board may consider this time limit to be applicable and not to have been met, it is requested that the Board authorize in writing a waiver of this requirement in this case. This is particularly appropriate here in light of the fact that the attached Supplemental Reply Brief raises only arguments that are in the reply brief timely filed in the divisional application appeal and will thus be before the Board at time of oral argument anyway. It will not take any substantial additional time for the Board to consider this supplemental reply brief at the

time that it prepares for the consolidated oral hearing that will presumably be ordered.

The petition fee in accordance with Board Rule 41.20(a) is being paid herewith. If there is any insufficiency in this fee, or if any other fees are deemed necessary for consideration of this petition or the attached supplemental reply brief, please charge same to deposit account no. 02-4035 of the undersigned.

Granting of this petition and entry of the attached Supplemental Reply Brief is therefore earnestly solicited.

Respectfully submitted,

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